

DOCKET NO.: NUMO-0030
Application No.: 10/805,698
Office Action Dated: July 29, 2005

PATENT

Amendments to the Drawings:

Please find attached four (4) replacement drawing sheets, which includes the proposed addition of Figure 4. As Figure 4 is merely an alternative view of the Boom Device illustrated in Figures 2 and 3, and all components of Figure 4 are detailed in specification paragraphs 19 through 27, the addition of Figure 4 by amendment at this time does not add new matter to the application. Further explanation is included in the Remarks portion of this Response and Amendment.

The four (4) attached replacement sheets, which include Figures 1-4, respectively, replace the three sheets including Figs. 1, 2 and 3, respectively.

Attached: Four (4) Formal Replacement Sheets.

REMARKS

Amendment to the Drawings

As a preliminary matter, applicant requests amendment to the drawings of this application, by requesting the addition of Figure 4 to the specification by preliminary amendment. Figure 4 is merely an alternative view of the Boom Device illustrated in Figures 2 and 3.

The Figure 4 view shows the Boom Device of Figures 2 and 3 with the screen 218 removed, to better show the upright support members 222, 224, the interconnecting bar 228, the bracing bar 232, and the screen hangers 230. However, each of these components are also illustrated in Figures 2 and 3, and are specifically detailed in specification paragraphs 0020 through 0023.

Further, the Figure 4 view omits, relative to that in Figures 2 and 3, the portion of the boom arm 214 extending backwardly from attachment point "A," and consequently omits the counterbalance weight 236 and spring-loaded mechanism 238 that are shown in Figures 2 and 3. However, this alternative embodiment of the boom device 210, as shown in Figure 4 relative to that shown in Figures 2 and 3, is clearly detailed in specification paragraph 0022.

Accordingly, Applicant's representative declares that the addition of Figure 4 by amendment at this time does not entail the addition of new matter to the application. Applicant, therefore, respectfully requests that the examiner allow the requested addition of Figure 4 to the specification.

Restriction Requirement

In the first office action, the examiner requires restriction to one of the following inventions under 35 U.S.C. §121:

Group I: Species 1, drawn to the stand of Figure 1; and

Group II: Species 2, drawn to the stand of Figures 2-4.

The examiner requires election of one group for prosecution on the merits, even if restriction is traversed, in accordance with 37 C.F.R. §1.143.

Statement of Election and Traversal

Applicant provisionally elects Group II (Species 2, drawn to the stand of Figures 2-4) for immediate prosecution, and respectfully traverses the restriction requirement, requesting reconsideration and withdrawal of same.

Applicant makes no representation by this election regarding the possible existence of multiple independent and/or distinct inventions among the claims of record. Pursuant to 37 C.F.R. § 1.143, the request for reconsideration is made to preserve applicant's right of petition should the examiner reassert restriction.

Identification of Species and Claims Readable Thereon

The examiner requires that this response include a list of all claims readable on each of the species. Accordingly, applicant submits that claim 1 is readable on Group I (Species 1, drawn to the stand of Figure 1), and claims 1-9 are readable of Group II (Species 2, drawn to the stand of Figures 2-4). Accordingly, claim 1 is generic.

Generic Claim

Applicant submits that claim 1 is generic, and that applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all of the limitations of an allowed generic claim, as provided by 37 CFR §

1.141. Applicant submits that, if claims are added after election, applicant will indicate which are readable upon the elected species. MPEP § 809.02.

Further:

Examiner's requirement of demonstrating extra burden on the PTO has not been satisfied

Even if two or more claim groupings are independent or distinct as claimed, there must also be a serious burden on the examiner to require restriction. M.P.E.P. §803. If the search and examination of the entire application can be made without serious burden, the examiner must examine the application on its merits, in its entirety, even though the application includes claims to distinct and/or independent inventions. M.P.E.P. §803. The examiner has failed to show, in the present case, that examining the groups on the merits would present a serious burden.

In the office action, the examiner fails to show, or even mention, that a search and examination of the entire application would present a serious burden. The examiner, therefore, has not satisfied the criteria necessary for requiring restriction in this application.

Indeed, M.P.E.P. §803 requires, for proper restriction:

**CRITERIA FOR RESTRICTION BETWEEN
PATENTABLY DISTINCT INVENTIONS**

There are two criteria for a proper requirement for restriction between patentably distinct inventions:

(A) The inventions must be independent (see MPEP § 802.01, § 806.04, § 808.01) or distinct as claimed (see MPEP § 806.05 - § 806.05(i)); *and*

(B) There must be a serious burden on the examiner if restriction is required (see MPEP § 803.02, § 806.04(a) - § 806.04(i), § 808.01(a), and § 808.02).

Applicant respectfully submits that since the examiner has not addressed the second criteria (part B), the examiner has failed to satisfy his burden to show that restriction is proper. In fact, the examiner has not clearly addressed the first criteria (part A). In the restriction requirement, the examiner merely concludes that the application contains claims directed to patentably distinct species, without articulating whether the species are independent or distinct.

Further, regarding part B, even if the examiner were to conclude that search and examination of the entire application would create a serious burden, which the examiner has not, M.P.E.P. §803 further requires that the examiner provide reasons and/or examples to support the conclusions. In the instant case, the examiner provides no reason or example to support the conclusion. The examiner does not claim that examination of any group requires search in a class or subclass having no art pertinent to the other groups. In fact, the examiner associates no class or subclass with either of the species. Nor does the examiner indicate the purported different field of search. Even if the examiner indicated the different field of search, an explanation of how the different field of search was pertinent to the respective group, and only that group, is necessary.

Practical and equitable considerations mandate review of applicant's claims as a single application

A close examination of the practical and equitable considerations surrounding the present case compels withdrawal of the examiner's restriction requirement and requires inclusion of all the claims presented by applicant in a single patent application. The salient consideration for insisting upon restriction and determining the propriety of a restriction requirement is the scope of the examiner's search for prior art. Applicant is entitled to a full

and thorough search of the prior art as a consequence of having filed his application and having paid the statutory application fee. 35 U.S.C. §131.

The examiner's instructional guidelines for performing such a search for any application are set forth in the M.P.E.P. The guidelines compel the examiner to search in classes and subclasses in which independent and distinct inventions would be classified. For example, §904.01(c) recites:

"Not only must the art be searched with which the invention claimed is classifiable, but also all analogous arts regardless of where classified. The determination of when arts are analogous is at times difficult. It depends upon the necessary essential function or utility of the subject matter covered by the claims, and not upon what it is called. (emphasis added).

MPEP §904.01(d) recites:

A proper field of search includes the subclass in which the claimed subject matter of an application would be properly classified.

In outlining a field of search the examiner should note every class and subclass under the U.S. Patent Classification system and other organized systems of literature, that may have material pertinent to the subject matter as claimed. Every subclass, digest and cross reference art collection pertinent to each type of invention claimed should be listed, from the largest combination through the various subcombinations to the most elementary part. The search should extend to all probable areas relevant to the claimed subject matter and should cover the disclosed features which might reasonably be expected to be claimed.

The examiner should plan a search that not only covers the claimed subject matter, but one that also covers the disclosed features that might reasonably be expected to be claimed.

MPEP §904.02 recites:

It is a prerequisite to a speedy and just determination of the issues involved in the examination of an application that a careful and comprehensive search, commensurate with the limitations appearing in the most detailed claims in the case, be made in preparing the first action on the merits so that the second action on the merits can be

made final or the application allowed with no further searching other than to update the original search. It is normally not enough that references be selected to meet only the terms of the claims alone, especially if only broad claims are presented; but the search should, insofar as possible, also cover all subject matter which the examiner reasonably anticipates might be incorporated into applicant's amendment.

It thus results that the examiner finds references that, while not needed for treating the claims, would be useful for forestalling the possible presentation of claims to other subject matter regarded by applicant as his or her invention, and claimable with the subject matter being currently claimed, but shown to be old by these references.

From the above-quoted guidelines, it is clear that the scope of a proper search includes:

- (1) classes and subclasses in which the claimed subject matter is classified;
- (2) classes and subclasses that may have material pertinent to the claimed subject matter;
- (3) classes and subclasses containing subject matter present in the disclosure which might reasonably be expected to be claimed during the prosecution; and
- (4) classes and subclasses that may contain subject matter disclosing material related to features which might reasonably be expected to be claimed.

Examination of Groups I and II will require overlapping searches

Only where inventions are independent and distinct and require non-overlapping searches, is restriction proper. Art relevant to an individual group, in the instant case, will overlap considerably with the art relevant to the other group. Accordingly, the examiner will be required, during a search of either group, to search the respective subclasses of the other group.

Thus, the examiner will not be unduly burdened by searching and examining all of the claims presented by applicant in a single application. The examiner's search will not be narrowed or reduced by compliance with the restriction requirement, since applicant has clearly manifested its intent to claim each novel and non-obvious aspect of the invention as evidenced by the claims in the application.

Examiner has failed to show separate classification, or separate status in the art, or a different field of search as defined in MPEP § 808.02

The examiner concludes that Species 1 and 2 are patentably distinct, but fails to provide a reason why. The examiner has failed to show separate classification, or separate status in the art, or a different field of search as defined in MPEP § 808.02. We assume the examiner believes that the Species have different classifications. In the office action, however, the examiner has failed to satisfy the burden of showing separate classification.

(Note: applicant assumes that the examiner relies on different classification, and not on separate status in the art, in concluding that restriction is proper, since separate status in the art, as referenced below in M.P.E.P. §808.02(B), requires that the groups be classified together, and requires that an explanation indicating a recognition of separate inventive effort by inventors be provided. In the present case, however, the examiner does not state that the groups are classified differently, and does not mention an explanation indicating recognition of separate inventive effort by inventors).

The examiner's requirement for satisfying separate classification is articulated in M.P.E.P. §808.02 *Related Invention*:

Where the related inventions as claimed are shown to be distinct under the criteria of MPEP § 806.05(c) - § 806.05(i), **the examiner**, in order to establish reasons for insisting upon restriction, **must show** by appropriate explanation one of the following:

- (A) **Separate classification thereof:** This shows that each distinct subject has attained recognition in the art as a separate subject for inventive effort, *and* also a separate field of search. Patents need not be cited to show separate classification.
- (B) **A separate status in the art when they are classifiable together:** **Even though they are classified together:** each subject can be shown to have formed a separate subject for inventive effort when an explanation indicates a recognition of separate inventive effort by inventors. Separate status in the art may be shown by citing patents which are evidence of such separate status, and also of a separate field of search.
- (C) **A different field of search:** Where it is necessary to search for one of the distinct subjects in places where no pertinent art to the other subject exists, a different field of search is shown, even though the two are classified together. The indicated different field of search must in fact be pertinent to the type of subject matter covered by the claims. Patents need not be cited to show different fields of search.

The examiner has failed to show separate field of search, as required by M.P.E.P. §808.02(A). The examiner, in requiring restriction, has failed to even mention separate field of search. Accordingly, the examiner has failed to satisfy his burden of showing that restriction, in the present case, is proper.

Applicant submits that it would not be necessary, in the present application, for the examiner "to search for one of the distinct subjects in places where no pertinent art to the other subject exists." M.P.E.P. §808.02(C). Accordingly, Groups I and II of the present application do not require a separate field of search.

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CONCLUSION

In view of the foregoing, applicant respectfully requests reconsideration and withdraw of the restriction requirement. Notification that the restriction requirement has been reconsidered and withdrawn is respectfully solicited.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Bruce D. George", is written over a horizontal line.

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